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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,531	12/04/2003	E. Vanessa Boone	BOONE-1	7942

7590 07/05/2005

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EXAMINER	
SPAHN, GAY	

ART UNIT	PAPER NUMBER
3673	

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/726,531	BOONE, E. VANESSA	
	Examiner	Art Unit	
	Gay Ann Spahn	3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 February 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5 and 8-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5 and 8-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 February 2005* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Drawings

In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

Replacement Drawing Sheets

Drawing changes must be made by presenting replacement sheets which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments section, or remarks, section of the amendment paper. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). A replacement sheet must include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and within the top margin.

Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheet(s) must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change(s) to the drawings.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

Specification

The amendment filed 22 February 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

(1) claim 1, lines 5-6, wherein it recites that "the head pillow having a top surface of an area having an extent substantially the size of a person's head." In the Summary of the Invention section, the specification states that the "headrest is configured of a pillow made of resilient material such as foam, which pillow has projecting therefrom a foam head supporting surface of limited area which engages only a small portion of the person's head," but this is not enough to support the limitation that the head pillow has a top surface with an area having an extent substantially the size of a person's head.

(2) claim 3, line 3, "the outer slip having a pocket which receives the head pillow."

Applicant is required to cancel the new matter in the reply to this Office Action.

The disclosure is objected to because of the following informalities:

Reference numeral "40" is called: an "outer pillow slip" on page 5, lines 1, 9, 11; a "top cover" on page 5, line 13, and page 6, lines 5, 17 and 18; a "cover" on page 5, line 18; a "smoother top cover" on page 6, line 10; and a "satin surface" on page 7, line 5. Which is it? Terminology throughout the specification must be consistent.

Appropriate correction is required.

The use of the trademark Velcro® (on page 5, line 15, and page 6, lines 13 and 15) and Nylon® (on page 6, line 12) has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology (e.g., hook and loop fastener for Velcro®). The examiner believes that nylon is no longer a trademark (i.e., that DuPont (or whatever company owned the trademark) lost its rights to the trademark "nylon" years ago and the term has become generic). However, Applicants should investigate as to whether nylon is still a trademark and if not, the references to nylon being a trademark should be removed from the present patent application.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

Claims 4 and 12 are objected to because of the following informalities:

(1) claim 4, line 3, the use of a trademark such as "NYLON®" is not permitted in claims (i.e., claims must use the generic terminology). However, the examiner believes that nylon is no longer a trademark (i.e., that DuPont (or whatever company owned the rights to the trademark) lost its rights to the trademark "nylon"). However, Applicants should investigate as to whether nylon is still a trademark and if not, the references to nylon being a trademark should be removed from the present patent application.

(2) claim 12, line 2, the use of a trademark such as "VELCRO®" is not permitted in claims (i.e., claims must use the generic terminology such as hook and loop fasteners).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 and 8-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed,

had possession of the claimed invention. More particularly, there is no support in the specification for:

(1) lines 5-6 of claim 1 wherein it recites that "the head pillow having a top surface of an area having an extent substantially the size of a person's head." In the Summary of the Invention section, the specification states that the "headrest is configured of a pillow made of resilient material such as foam, which pillow has projecting therefrom a foam head supporting surface of limited area which engages only a small portion of the person's head," but this is not enough to support the limitation that the head pillow has a top surface with an area having an extent substantially the size of a person's head.

(2) line 3 of claim 3 wherein it recites "the outer slip having a pocket which receives the head pillow." The specification discusses outer pillow slip 40, but does not provide support for the outer slip having a "pocket." The word "pocket" is not disclosed in the specification and therefore, it is unclear as to what structure the pocket has.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 and 8-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, lines 11-13, recites "the free area extending both back and beyond the head pillow and laterally of the base pillow to provide a space for a person's hair to occupy uncompressed by the head pillow." How can the "free area" extend laterally of

the base pillow? Does applicant mean laterally of the --head-- pillow? If so, appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rinz.

As to claim 1, Rinz discloses a headrest (Figs 1-5) for elevating a person's head to minimize pressure against the person's hair while the head is resting on the head rest, comprising:

a base pillow (17) for resting on a supporting surface, the base pillow (17) having a top surface of a selected area, a bottom surface and a selected thickness;

a head pillow (16) made of compressible foam material (see col. 2, lines 26-28 wherein it states that "[t]he insert 16 is made of a soft, resilient, elastomeric material such as polyurethane foam or polyester foam") and formed as a raised portion of the base pillow, the head pillow (16) having a top surface of an area substantially less than the top surface area of the base pillow (17) upon which the person's head rests, and being positioned at a location on the base pillow (17) spaced from a substantial portion of the periphery of the base pillow (17) to define a free area on the top surface of the

base pillow (17) at an elevation less than that of the head pillow (16) for receiving at least a substantial portion of the person's hair, the free area extending both back beyond the head pillow (see top portion of Fig. 1) and laterally of the head pillow (see spaces on left and right side of Fig. 4) to provide a space for the person's hair to occupy uncompressed by the head pillow (16).

The examiner notes that the preamble's recitation of "for elevating a person's head to minimize pressure against the person's hair while the head is resting on the head rest" is a statement of intended use and that the Rinz reference is capable of performing this intended use.

However, Rinz fails to explicitly disclose that the base pillow is made of a compressible foam material and that the head pillow has an extent substantially the size of a person's head.

The examiner notes that base pillow 17 of Rinz is disclosed to be "a conventional pillow" (col. 2, line 18) and that it is notoriously well known for conventional pillows to be made of compressible foam materials.

With respect to the recitation that "the head pillow having a top surface of an area having an extent substantially the size of a person's head", it is noted that at col. 2, lines 21-25, Rinz discloses that "[t]he insert may have a diameter in the range of about 4 inches to 5 inches, and preferably 5 inches, and may have a length in the range of about 17 inches to 19 inches, and preferably 17 inches." While, the width of the head pillow (16) being about 4 or 5 inches is considered to meet the recitation of "having an extent substantially the size of a person's head", the 17 to 19 inch length of the head

pillow (16) is probably too long to meet the recitation of "having an extent substantially the size of a person's head." However, it is well settled that "[g]enerally, it is not invention to change size or degree of thin or of any feature or function of machine or manufature; there in no invention where change does not involve different concept, purposes, or objects, but amounts to doing same thing substantially the same way with better results." (See *Hobbs v. Wisconsin Power and Light Company et al.*, 115 USPQ 371 (CA 7 1957). Further, "[i]mprovement resulting from change in size, proportion, or degree of element contained in prior art, no matter how desirable or useful, does not constitute patentable invention." (See *The Ward Machinery Company v. Wm. C. Staley Machinery Corporation*, 192 USPQ 505 (DC Md 1976).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the headrest of Rinz so that the base pillow is made of a compressible foam material and that the head pillow has an extent substantially the size of a person's head in order to save on material costs by making the head pillow the size of the user's head.

As to claim 2, Rinz discloses the headrest of claim 1 as discussed above, and Rinz also discloses that a fabric covering (pillowcase 10) is positioned over at least the top surfaces of the base pillow (17) and the head pillow (16).

Claims 3-5, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rinz (U.S. Patent No. 4,754,513), as applied to claims 1 and 2 above, and further in view of Greco (U.S. Patent No. 2,851,703).

As to claim 3, Rinz discloses the headrest of claim 2 as discussed above, but Rinz fails to explicitly disclose that the fabric covering includes a removable outer slip of smooth material and an inner slip of course material, the outer slip having a pocket which receives the head pillow.

Greco discloses a fabric covering including a removable outer slip (fitted cover 10) of smooth material (see col. 1, lines 63-64 wherein it states that fitted cover 10 may be made of material such as "cotton, silk, nylon or orlon") and an inner slip (mattress 20) of course material (mattresses having outer covers of course material are notoriously well known and the examiner takes Official Notice of this), the outer slip (10) having a pocket (see Fig. 4) which receives the head pillow.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the headrest of Rinz by providing a fabric covering which includes a removable outer slip of smooth material having a pocket to receive the head pillow and an inner slip of course material as taught by Greco in order to provide durability to protect the foam inside the inner slip, which at the same time provide comfort to the user by making the outer slip soft to the user's skin.

As to claim 4, Rinz in view of Glaze discloses the headrest of claim 3 as discussed above, and Glaze discloses that the outer slip is one of a high-count cotton, satin, silk, or NYLON®.

Glaze does not explicitly disclose that the inner slip or mattress (22) is of a course material such as low thread count cotton. However, using a course material

such as low thread count cotton for mattress covers is so notoriously well known in the bed art that the examiner is taking Official Notice thereof.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the headrest of Rinz to include an inner slip of course material such as low thread count cotton and an outer slip of any one of high-count cotton, satin, silk, or NYLON® in order to provide durability to protect the foam inside the inner slip, which at the same time provide comfort to the user by making the outer slip soft to the user's skin.

As to claim 5, Rinz in view of Glaze discloses the headrest of claim 3 as discussed above, and Glaze also discloses that the inner slip (mattress 22) is a permanent covering.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the headrest of Rinz to include an inner slip which is a permanent covering in order to provide durability to protect the foam inside the inner slip.

As to claim 11, Rinz in view of Greco discloses the headrest of claim 3 as discussed above, and Greco discloses that the outer slip extends over the top surface of the base pillow and over a portion of the bottom surface in overlapping relationship with a bottom cover (unnumbered, but attached by buttons 66) that is detachably secured over the bottom surface of the base pillow (mattress 22).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the headrest of Rinz by providing a detachable bottom

cover to the covering of the base pillow and make the outer slip cover the bottom surface of the base pillow and the bottom cover in overlapping relationship as taught by Greco in order to protect the inner foam of the headrest, but allow for taking the foam out so that the inner and outer slips may be cleaned and replaced.

As to claim 12, Rinz in view of Greco discloses the headrest of claim 3 as discussed above, but Rinz in view of Greco fails to explicitly disclose that the cover is attached to the inner slip by VELCRO® fasteners. Rather Greco discloses button fasteners. However, because Velcro fasteners are a well known equivalent of button fasteners, the examiner deems Velcro fasteners to be an obvious expedient of button fasteners.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rinz by attaching the bottom cover to the inner slip by means of button fasteners as taught by Greco or equivalent Velcro fasteners since they are such well known equivalents of button fasteners in order to allow for ease of removing the inner foam and cleaning of the inner and outer slips.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rinz (U.S. Patent No. 4,754,513), as applied to claims 1 and 2 above, and further in view of Austin (U.S. Patent No. 5,360,017).

As to claim 8, Rinz discloses the headrest of claim 1 as discussed above, and Rinz also discloses that the base pillow is rectangular, but Rinz fails to explicitly disclose that the head pillow has a rectangular top surface.

Austin discloses a headrest (10) wherein the base pillow (12) is rectangular and that the head pillow (22) has a rectangular top surface.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the headrest of Rinz so as to make the head pillow have a rectangular top surface as taught by Austin in order to provide more surface area for the user's head to rest upon.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rinz (U.S. Patent No. 4,754,513), as applied to claims 1 and 2 above, and further in view of Priester, III et al. (U.S. Patent No. 6,047,420).

As to claim 9, Rinz discloses the headrest of claim 1 as discussed above, but Rinz fails to explicitly disclose that the base pillow is made of a first foam material and the head pillow is made of a first layer of stiff foam positioned adjacent to the base pillow and a second layer of flexible foam near an upper most surface of the head pillow which second layer is adjacent to a person's head during use of the headrest.

Priester, III et al. disclose that the base pillow (18) is made of a first foam material (see col. 4, line 12, flexible fabric) and the head pillow (11) is made of a first layer of stiff foam (unnumbered, but beneath 13) positioned adjacent to the base pillow (18) and a second layer of flexible foam (13) near an upper most surface of the head pillow which second layer is adjacent to a person's head during use of the headrest.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rinz by including a two-layered head pillow made of a

firm foam adjacent the base pillow and a softer foam adjacent the head of the user as taught by Priester, III et al. in order to provide firm support for the user's head with the firmer foam while at the same time providing for the user's comfort with the softer foam.

As to claim 10, Rinz in view of Priester, III et al. discloses the headrest of claim 9 as discussed above, and Rinz and Priester, III et al. both disclose the use of urethane foam of sufficient stiffness to retain its form.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rinz so that both the base pillow and head pillow where made of blocks of sufficiently stiff urethane foam to retain its form as taught by Priester, III et al. in order to provide the user with sufficient support for his head while at the same time maintaining the user's comfort.

Response to Amendment

The Declaration Traversing Rejections under 37 CFR 1.132 (hereinafter "Declaration") filed 22 February 2005 is insufficient to overcome the previous rejections as set forth in the last Office action mailed on 21 October 2005 and the present rejections set forth above because:

(1) it is not apparent what Applicant is alleging by her Declaration. In other words, it is not clear if Applicant is alleging secondary considerations such as commercial success, long felt need, or copying by other. In addition, if Applicant is alleging secondary considerations, then it is not clear what secondary consideration Applicant is alleging.

(2) regardless of whether Applicant is alleging a secondary consideration, Applicant has not shown that there is a nexus between the product discussed in the Declaration and the present invention as defined by the claims of the instant application. In other words, Applicant has failed to present evidence, such as brochures or advertisements which show that the headrest she is selling is the same as the headrest defined in the claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 6,584,631 to Jones, Sr. discloses a support pillow for maintaining a hairstyle. U.S. Patent No. 2,700,779 to Tolkowsky discloses a therapeutic pillow. U.S. Patent No. 4,550,459 to Endel et al. discloses an orthopedic pillow. U.S. Patent No. 5,367,731 to O'Sullivan discloses a therapeutic pillow having an exterior depression on one side for providing different degrees of support to a user's neck. U.S. Patent Application Publication No. 2001/0018777 to Walpin discloses an orthopedic head and neck support pillow that requires no break-in period.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gay Ann Spahn whose telephone number is (571)-272-7731. The examiner can normally be reached on Monday through Thursday, 8:30 am to 7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather C. Shackelford can be reached on (571)-272-7049. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GAS

Gay Ann Spahn, Patent Examiner
June 21, 2005

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